REMARKS

Claims 1-8, 10, 11 and 13-41 are pending in the application. Claims 1-8, 10, 11 and 13-41 are rejected under 35 U.S.C. §103. Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully requests the Examiner to reconsider and withdraw these rejections.

I.   REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1, 10, 16-20, 33 and 40 under 35 U.S.C. §103(a) as being unpatentable over Gramlich (U.S. Patent No. 5,826,025) in view of Day et al. (U.S. Patent No. 6,243,722) (hereinafter "Day"). The Examiner has further rejected claims 2-8, 11, 13-15, 34-38 40 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Day and in further view of Tran (U.S. Patent No. 6,054,990). The Examiner has further rejected claims 21-24, 39 and 41 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Day in further view of Tran and in further view of Merritt et al. (U.S. Patent No. 6,041,335) (hereinafter "Merritt"). The Examiner has further rejected claims 25-32 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Tran and in further view of Merritt. Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully requests the Examiner to reconsider and withdraw these rejections.

A.   The Examiner has not presented any objective evidence for combining Gramlich and Day.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. § 2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614,

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1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Gramlich with Day to request the source file using unmodified standard messaging protocols, as recited in claim 1 and similarly in claims 21, 33 and 39 is to "provide Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (see Day column 7 lines 27-28)." Paper No. 20, pages 3 and 9. This motivation is insufficient to support a *prima facie* case of obviousness as discussed below.

Gramlich teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents. Abstract. Gramlich further teaches that a user of a web browser opens an annotation proxy server between the web browser and the web servers that intercepts all documents retrieved by the web browser and merges with the retrieved documents commentary from sources designated by the user of the web browser that refer to the requested documents. Abstract. Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. Abstract.

Day, on the hand, teaches that initially, a document is displayed in a graphic interface of a computer in a computer network, such that the document may also be displayed at any one of a number of computers within the computer network. Abstract. Day further teaches that next, portions of the document are designated which may be commented upon by users. Abstract. Day further teaches that these portions of the document are automatically associated with displayable interface wherein users may enter comments pertaining to the document. Abstract. Day further teaches that the displayable interface is then displayed within the graphic interface, in response to user input. Abstract. Day further teaches that a user is then permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the

creation of the document without cluttering. Abstract. Day further teaches that the displayable interface is then automatically closed upon completion of an entry of comments pertaining to the document within the displayable interface.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying the primary reference (Gramlich) to provide Gramlich the benefit of capitalizing on the ubiquity of (typical) web browsers (Examiner's motivation). *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation appears to have been gleaned from the secondary reference (Day). In fact, the Examiner cites column 7, lines 27-28 of Day as support for his motivation. Paper No. 20, page 3. This is not evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him would have been motivated to modify the primary reference (Gramlich) with the teachings of the secondary reference (Day). The Examiner's motivation is a motivation for the secondary reference (Day) to solve its problem. This is not a suggestion to combine the primary reference (Gramlich) with the secondary reference (Day). As stated above, the primary reference (Gramlich) teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. The Examiner must provide evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him, which teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory with the teachings of the secondary reference (Day), which teaches that a user is permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating what the secondary reference teaches is <u>not</u> evidence for combining a primary reference

(Gramlich) with the secondary reference (Day). *See Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-8, 10, 11, 13-24 and 29-41. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to request the source file using unmodified standard messaging protocols. *Id.* There is no suggestion in Gramlich of using unmodified standard messaging protocols. Since the Examiner has not submitted objective evidence for modifying Gramlich to request the source file using unmodified standard messaging protocols, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-8, 10, 11, 13-24 and 29-41. *Id.*

As a result of the foregoing, Applicant respectfully asserts that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-8, 10, 11, 13-24 and 29-41. M.P.E.P. §2143.

B. Gramlich and Day, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicant respectfully asserts that Gramlich and Day, taken singly or in combination, do not teach or suggest "system user are uniquely identified in the system and in which the means for accepting new comments further comprises means for selectively restricting the inclusion of new comments in the set of comments based on the unique identity of system users" as recited in claim 16. The Examiner cites column 8, lines 46-54 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 5. Applicant respectfully traverses and asserts that Gramlich instead teaches that members of different political parties might contribute overlays to overlay groups. Gramlich further teaches that in a magazine model, paid authors submit annotations to a centralized editor who then edits and publishes the authors' annotation overlays in an overlay group(s) managed by the editor. Gramlich further teaches that in this magazine model, it is envisioned that publishers of overlay groups will sell subscriptions or, like commercial broadcasters, advertising, to cover the costs

of publication. There is no language in the cited passage of restricting the inclusion of new comments. Neither is there any language in the cited passage of restricting the inclusion of new comments based on the unique identity of system users. Therefore, the Examiner has not presented a *prima facie* case of obviousness since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant respectfully asserts that Gramlich and Day, taken singly or in combination, do not teach or suggest that "the source file is associated with a defined cutoff date and in which the means for accepting new comments further comprises means for selectively restricting the inclusion of new comments on dates past the defined cutoff date" as recited in claim 17. The Examiner cites column 8, lines 40-54 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 5. Applicant respectfully traverses. As stated above, Gramlich instead teaches that members of different political parties might contribute overlays to overlay groups. Gramlich further teaches that in a magazine model, paid authors submit annotations to a centralized editor who then edits and publishes the authors' annotation overlays in an overlay group(s) managed by the editor. Gramlich further teaches that in this magazine model, it is envisioned that publishers of overlay groups will sell subscriptions or, like commercial broadcasters, advertising, to cover the costs of publication. There is no language in the cited passage of a cutoff date. Neither is there any language in the cited passage of restricting the inclusion of new comments. Neither is there any language in the cited passage of restricting the inclusion of new comments based on a cutoff date. Therefore, the Examiner has not presented a *prima facie* case of obviousness since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, in connection with the rejection of the above-claim limitation, the Examiner states that "the limitation of defined cutoff dates and restricting comments on dates past said cutoff date would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gramlich, because Gramlich teaches selling

subscriptions to overlay groups (in a magazine model), suggesting the use of cutoff dates and deadlines for article submission and user/author inclusion (Gramlich column 8 lines 40-54; compare with claim 17), providing a user of Gramlich the benefit of providing a periodical magazine structure." Paper No. 20, page 5. Applicant respectfully traverses. The Examiner has not submitted any objective evidence, as required in an obviousness rejection, for modifying Gramlich to have a source file associated with a defined cutoff date and in which the means for accepting new comments further comprises means for selectively restricting the inclusion of new comments on dates past the defined cutoff date. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Instead, the Examiner relies on his own <u>subjective</u> opinion. The Examiner states that Gramlich teaches selling subscriptions to overlay groups (in a magazine model). Applicant respectfully disagrees and respectfully points out that Gramlich instead teaches that "it is envisioned that publishers of overlay groups will sell subscriptions." Column 8, lines 51-52. Hence, Gramlich teaches that publishers of overlay groups sell subscriptions and does not teach selling subscriptions to overlay groups. Further, there is no language in the cited passage that suggests a cutoff date or the use of a deadline for article submission or the use of a deadline for user/author inclusion. The Examiner is merely relying on his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. Consequently, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 17. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); M.P.E.P. §2143.

Applicant further asserts that Gramlich and Day, taken singly or in combination, do not teach or suggest "means to collect and display statistics relating to the set of comments" as recited in claim 19. The Examiner cites column 13, lines 8-13 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 5. Applicant respectfully traverses and asserts that Gramlich instead teaches that a merged document can be displayed in a browser in any number of ways selected by the user. Gramlich further teaches that the linked text may be displayed inline or linked to an icon, displayed at the position of the HTML tag. However, there is no language in the cited passage that teaches collecting statistics relating to comments. Neither is there any language in the cited passage that teaches displaying such

statistics. Therefore, the Examiner has not presented a *prima facie* case of obviousness since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting the above-cited claims as being unpatentable over Gramlich in view of Day. M.P.E.P. §2143.

C.　The Examiner has not presented any objective evidence for combining Gramlich, Day and Tran.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. § 2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Gramlich with Day and Tran for representing a source file as a linked list of objects corresponding to a hypertext representation of the source file where the markup file is a binary file representation of the linked list, as recited in claim 2 and similarly in claims 21, 25, 29, 34 and 39, is "because of Tran's taught advantage of linked lists, providing a user of Gramlich with a way to dynamically store file." Paper No. 20, pages 6 and 8. This motivation is insufficient to support a *prima facie* case of obviousness as discussed below.

As stated above, Gramlich teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents. Abstract. Gramlich further teaches that a user of a web browser opens an annotation proxy server between the

web browser and the web servers that intercepts all documents retrieved by the web browser and merges with the retrieved documents commentary from sources designated by the user of the web browser that refer to the requested documents. Abstract. Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. Abstract.

As stated above, Day, on the hand, teaches that initially, a document is displayed in a graphic interface of a computer in a computer network, such that the document may also be displayed at any one of a number of computers within the computer network. Abstract. Day further teaches that next, portions of the document are designated which may be commented upon by users. Abstract. Day further teaches that these portions of the document are automatically associated with displayable interface wherein users may enter comments pertaining to the document. Abstract. Day further teaches that the displayable interface is then displayed within the graphic interface, in response to user input. Abstract. Day further teaches that a user is then permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering. Abstract. Day further teaches that the displayable interface is then automatically closed upon completion of an entry of comments pertaining to the document within the displayable interface.

Tran, on the other hand, teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Abstract.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying the primary reference (Gramlich) to , provide a user of Gramlich with a way to dynamically store file (Examiner's

motivation). *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation appears to have been gleaned from a secondary reference (Tran). In fact, the Examiner states "because of Tran's taught advantage of linked lists" as support for his motivation. Paper No. 20, page 6. This is not evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him would have been motivated to modify the primary reference (Gramlich) with the teachings of the secondary references (Day and Tran). The Examiner's motivation is a motivation for the secondary reference (Tran) to solve its problem. This is not a suggestion to combine the primary reference (Gramlich) with the secondary references (Day and Tran). As stated above, the primary reference (Gramlich) teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. The Examiner must provide evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him, which teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory with the teachings of the secondary reference (Day), which teaches that a user is permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering, with the teachings of the other secondary reference (Tran), which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating what a secondary reference teaches is <u>not</u> evidence for combining a primary reference (Gramlich) with the secondary references (Day and Tran). *See Id.* Consequently, the Examiner's motivation is insufficient to

support a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15, 21-24, 29-32 and 34-41. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Gramlich, which teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents, with Day, which teaches that a user is permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering, along with Tran, which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). There is no suggestion in Gramlich of accepting and processing hand sketches. Neither is there any suggestion in Gramlich of accepting and processing writings. Neither is there any suggestion in Gramlich of accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing. Neither is there any suggestion in Gramlich of using a hand-held, mobile computer with a relatively compact screen. Since the Examiner has not submitted objective evidence for modifying Gramlich with Day and Tran, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15, 21-24, 29-32 and 34-41. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to represent a source file as a linked list of objects corresponding to a hypertext representation of the source file where the markup file is a binary file representation of the linked list. *Id.* There is no suggestion in Gramlich of using a linked list. Neither is there any suggestion in Gramlich of representing a source file as a linked list of objects. Neither is there any suggestion in Gramlich of representing a source file as a linked list of objects corresponding to a hypertext representation of the source file. Neither is there any suggestion in Gramlich of representing a source file as a linked list of objects

corresponding to a hypertext representation of the source file where the markup file is a binary file representation of the linked list. Since the Examiner has not submitted objective evidence for modifying Gramlich to represent a source file as a linked list of objects corresponding to a hypertext representation of the source file where the markup file is a binary file representation of the linked list, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15, 21-24, 29-32 and 34-41. *Id.*

As a result of the foregoing, Applicant respectfully asserts that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15, 21-24, 29-32 and 34-41. M.P.E.P. §2143.

> D.   By combining Gramlich with Tran, the principle of operation of Gramlich would change.

If the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Applicant submits that by combining Gramlich with Tran, the principle of operation in Gramlich would change and subsequently render the operation of Gramlich to perform its purpose unsatisfactory.

As stated above, Gramlich teaches a system and method for providing annotation overlays from diverse sources of commentary for World-Wide Web (WWW) documents. Abstract. Gramlich further teaches that the annotation overlays are stored on one or more overlay servers, which are connected to the Web.

Tran, on the other hand, teaches that the ability to quickly create and attach text or graphical illustrations to a message, file, data set or recording media is needed in many applications, including photographic annotation and two-way

communications. Column 2, lines 59-62. Tran further teaches that existing cameras doe not offer a light weight and reliable solution for recording camera settings and drawing/text annotations on the film. Column 4, lines 63-65. Further, Tran teaches that the ability to annotate a message with drawings is also important in the communications applications in the two-way messaging industry and the cellular communications industry. Column 4, line 66 - Column 5, line 2. Tran further teaches that the present invention provides a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Column 5, lines 25-29. Tran further teaches that an object classification and recognition capability is provided to recognize objects being sketched by the user and to convert the hand sketches into CAD-like drawings. Column 5, lines 32-35. Tran further teaches that the graphical data entry system of the present invention can be used in conjunction with a camera to annotate pictures taken with the camera. Column 5, lines 39-41.

By combining Gramlich with Tran, Gramlich would no longer be able to store annotation overlays on servers that would be used to annotate a WWW document. Tran does not teach annotating a WWW document but instead teaches annotating a drawing or a photograph. Furthermore, Tran does not teach storing these annotations on a server but instead storing these annotations on the data entry graphical system displaying the photograph or drawing. Hence, by combining Gramlich with Tran, the user in Gramlich would be annotating a drawing or photograph instead of a WWW document and would be storing these annotations on the user's data processing system. Thus, by combining Gramlich with Tran, the principle of operation in Gramlich would change, and subsequently render the operation of Gramlich to perform its purpose unsatisfactory. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15, 21-32, 34-39 and 41. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

E.   Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicant respectfully asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "means for accepting data from the source file and storing the source file as a markup file further comprises means for representing the source file as a linked list of objects corresponding to a hypertext representation of the source file, wherein the markup file is a binary file representation of the linked list" as recited in claim 2 and similarly in claim 34. The Examiner cites column 15, lines 30-39 of Tran as teaching the above-cited claim limitation. Paper No. 20, page 6. Applicant respectfully traverses and asserts that Tran instead teaches a routine to edit the objects drawn that includes the step of determining if the user wishes to flip graphical objects, e.g., magnifier 108 (Figure 2). If so, the routine flips the graphical objects. Further, the routine allows the user to enter text and to associate the text with selected graphical objects by adding the text to the linked list data structure for the objects. There is no language in the cited passage that teaches a linked list of objects corresponding to a hypertext representation of the source file. Applicant has performed a word search of "hypertext" in Tran and was unable to identify the word "hypertext" or any variation thereof in Tran. Neither is there any language in the cited passage that teaches a markup file that is a binary file representation of the linked list. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "means for representing the source file as a linked list of objects further comprises means for inserting comment insertion objects into the linked list of objects and in which the means for generating a hypertext document further comprises means to include hypertext data in the hypertext document to display one or more symbols representing each comment insertion object" as recited in claim 3 and similarly in claim 35. The Examiner cites column 12, lines 25-35 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 6. Applicant respectfully traverses and asserts that Gramlich instead teaches

that the annotation proxy inserts HTML tags in the merged document around the pattern to convert the pattern into a hyperlink cue tied to the appended information from the arg field. Gramlich further teaches that when displaying the merged document, the browser can display an icon at the insertion point, which a user can select to display the inserted text, or can directly display the inserted text at the insertion point. There is no language in the cited passage teaching a linked list of objects. Hence, Gramlich does not teaches inserting comment insertion objects into a linked list of objects. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "means for representing the source file as a linked list of objects further comprises means for inserting comment display objects into the linked list of objects, each comment display object being associated with a comment insertion object and in which the means for generating a hypertext document further comprises means to include hypertext data in the hypertext document to display comments in accordance with the corresponding comment display objects" as recited in claim 5 and similarly in claim 37. The Examiner cites column 12, lines 25-35 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 6. Applicant respectfully traverses and asserts that Gramlich instead teaches that the annotation proxy inserts HTML tags in the merged document around the pattern to convert the pattern into a hyperlink cue tied to the appended information from the arg field. Gramlich further teaches that when displaying the merged document, the browser can display an icon at the insertion point, which a user can select to display the inserted text, or can directly display the inserted text at the insertion point. There is no language in the cited passage teaching a linked list of objects. Hence, Gramlich does not teach inserting comment insertion objects into a linked list of objects and Gramlich does not teach including hypertext data in the hypertext document to display comments in accordance with the corresponding comment display objects. Therefore, the Examiner has not presented a *prima facie*

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case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "open tag data representing the open hypertext tags, at the location of the comment display object, in the linked list of objects and in which the means for generating a hypertext document further comprises means to insert closing hypertext data in the hypertext document, prior to a selected one of the comments being displayed in the hypertext document, and means to inset reopening hypertext data in the hypertext document, following the selected one of the comments being displayed in the hypertext document, the closing hypertext data and the reopening hypertext data both being defined by the open tag data for the comment display object associated with the selected one of the comments being displayed" as recited in claim 6 and similarly in claim 38. The Examiner cites column 12, lines 25-35 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 6. Applicant respectfully traverses. As stated above, Gramlich instead teaches that the annotation proxy inserts HTML tags in the merged document around the pattern to convert the pattern into a hyperlink cue tied to the appended information from the arg field. Gramlich further teaches that when displaying the merged document, the browser can display an icon at the insertion point, which a user can select to display the inserted text, or can directly display the inserted text at the insertion point. There is no language in the cited passage teaching a linked list of objects. Neither is there any language teaching open, closing or reopening hypertext tags or data. Hence, Gramlich does not teach the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "objects representing text are enclosed by objects representing paragraph tags, end of sentence indicators in objects in the linked list are represented in text, objects representing hypertext end tags are selectively

located in the linked list to close all hypertext tags, and objects representing unnecessary hypertext tags are removed from the linked list" as recited in claim 7. The Examiner cites column 15, lines 30-39 of Tran and column 9, lines 2-25 and column 13, lines 1-9 of Gramlich as together teaching the above-cited claim limitations. Paper No. 20, pages 6-7. Applicant respectfully traverses. As stated above, Tran instead teaches a routine to edit the objects drawn that includes the step of determining if the user wishes to flip graphical objects, e.g., magnifier 108 (Figure 2). If so, the routine flips the graphical objects. Further, the routine allows the user to enter text and to associate the text with selected graphical objects by adding the text to the linked list data structure for the objects. Further, Gramlich instead teaches that tags reference the inserted. Gramlich further teaches that the annotation proxy adds an HTML tag to the merged document at the end of each sentence. Gramlich further teaches that the merged document can be displayed in a browser in any number of ways selected by the user of the browser. However, the language in none of these passages in Tran and Gramlich teach that objects representing text are enclosed by objects representing paragraph tags. Neither is there language in either Tran or Gramlich that teaches that the end of sentence indicators in objects in the linked list are represented in text. Neither is there language in either Tran or Gramlich that teaches that objects representing hypertext end tags are selectively located in the linked list to close all hypertext tags. Neither is there language in either Tran or Gramlich that teaches that objects representing unnecessary hypertext tags are removed from the linked list. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest that the "linked list of objects comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item tag objects, and link tag objects" as recited in

claim 8. The Examiner cites column 15, lines 30-39 of Tran and column 9, lines 2-25 and column 13, lines 1-9 of Gramlich as together teaching the above-cited claim limitations. Paper No. 20, pages 6-7. Applicant respectfully traverses. There is no language in the cited passages that teach the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Day and Tran, taken singly or in combination, do not teach or suggest "each object in the linked list of objects has a type, and comprises contents derived from a portion of the source file, each comment insertion object and each comment display object comprises a contents line identifier, representing the line number defining the location of the object in relation to the source file, the comment file consists of comment line identifier data associated with the set of comments representing the line numbers in the source file with which each comment is related, and in which the means for generating a hypertext document further comprises means to traverse the linked list of objects comprising, and select a display object from the linked list of objects, means to determine the type of the display object, means to generate hypertext data to correspond to the type of the display object and the contents of the display object, means to identify the contents line identifier for the display object and for selecting comment display data from the comment file based on the contents line identifier and the comment line identifiers of the comment file, means to generate hypertext data from the comment file representing the selected one of the set of comments corresponding to the comment line identifier associated with the contents line identifier" as recited in claim 11. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50 and column 12, lines 32-42 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 7. Applicant respectfully traverses. In the Office Action, the Examiner is not addressing each of the limitations of the claim. For example, the Examiner has not addressed where a comment insertion object is allegedly taught. In another example, the Examiner has not addressed where a comment display object is allegedly taught. In another example, the Examiner has not addressed where the

limitation of "each object in a linked list of objects has a type" is allegedly taught and so forth. The Examiner is reminded that the Examiner may not simply ignore language in the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, the Examiner is reminded that the Examiner cannot reject claims based on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-8, 11, 13-15 and 34-38 as being unpatentable over Gramlich in view of Day and in further view of Tran. M.P.E.P. §2143.

> F. The Examiner has not presented any objective evidence for combining Gramlich, Day, Tran and Merritt.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. § 2142. The showings must be clear and particular and supported by objective evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

The Examiner's motivation for modifying Gramlich with Day, Tran and Merritt for providing reviewers with forms for reviewer entry of comments, as recited

in claims 21 and 39, "because of Merritt's taught advantage of including comments within a document, providing users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document." Paper No. 20, page 10. This motivation is insufficient to support a *prima facie* case of obviousness as discussed below.

As stated above, Gramlich teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents. Abstract. Gramlich further teaches that a user of a web browser opens an annotation proxy server between the web browser and the web servers that intercepts all documents retrieved by the web browser and merges with the retrieved documents commentary from sources designated by the user of the web browser that refer to the requested documents. Abstract. Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. Abstract.

As stated above, Day, on the hand, teaches that initially, a document is displayed in a graphic interface of a computer in a computer network, such that the document may also be displayed at any one of a number of computers within the computer network. Abstract. Day further teaches that next, portions of the document are designated which may be commented upon by users. Abstract. Day further teaches that these portions of the document are automatically associated with displayable interface wherein users may enter comments pertaining to the document. Abstract. Day further teaches that the displayable interface is then displayed within the graphic interface, in response to user input. Abstract. Day further teaches that a user is then permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering. Abstract. Day further teaches that the displayable interface is then automatically closed upon completion of an entry of comments pertaining to the document within the displayable interface.

As stated above, Tran, on the other hand, teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Abstract.

Merritt, on the other hand, teaches superimposing a second, graphical image on a primary image for annotating the primary image. Abstract. Merritt further teaches that the secondary image is displayed over the primary image as either a mark or glyph. Abstract.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying the primary reference (Gramlich) to provide users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document (Examiner's motivation). *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation appears to have been gleaned from a secondary reference (Merritt). In fact, the Examiner states "because of Merritt's taught advantage of including comments within a document" as support for his motivation. Paper No. 20, page 10. This is not evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him would have been motivated to modify the primary reference (Gramlich) with the teachings of the secondary references (Day, Tran and Merritt). The Examiner's motivation is a motivation for the secondary reference (Merritt) to solve its problem. This is not a suggestion to combine the primary reference (Gramlich) with the secondary references (Day, Tran and Merritt). As stated above, the primary reference (Gramlich) teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. The Examiner must provide evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him, which teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document,

merging with the requested document information only from the annotation directory with the teachings of the secondary reference (Day), which teaches that a user is permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering, with the teachings of the other secondary reference (Tran), which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen, along with the teachings of the other secondary reference (Merritt), which teaches superimposing a second, graphical image on a primary image for annotating the primary image. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating what a secondary reference teaches is <u>not</u> evidence for combining a primary reference (Gramlich) with the secondary references (Day, Tran and Merritt). *See Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 21-24 and 39-41. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Gramlich, which teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents, with Day, which teaches that a user is permitted to enter comments pertaining to the document within the displayable interface, such that the comments may be separately stored, subsequently retrieved and utilized in the creation of the document without cluttering, along with Tran, which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen, along with Merritt, which teaches superimposing a second, graphical image on a primary image for annotating the primary image. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). There is no suggestion in Gramlich of superimposing a second, graphical image on a primary image for annotating the primary image. Neither is there any suggestion in Gramlich that the secondary image

is displayed over the primary image as either a mark or glyph. Since the Examiner has not submitted objective evidence for modifying Gramlich with Day, Tran and Merritt, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 21-24 and 39-41. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to provide reviewers with forms for reviewer entry of comments. *Id.* There is no suggestion in Gramlich of providing reviewers with forms for reviewer entry of comments. Since the Examiner has not submitted objective evidence for modifying Gramlich to provide reviewers with forms for reviewer entry of comments, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 21-24 and 39-41. *Id.*

As a result of the foregoing, Applicant respectfully asserts that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 21-32 and 39-41. M.P.E.P. §2143.

G.   Gramlich, Day, Tran and Merritt, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicant respectfully asserts that Gramlich, Day, Tran and Merritt, taken singly or in combination, do not teach or suggest "a parser to parse a selected one of the set of source files into a linked list of objects corresponding to a hypertext representation of the selected source file, the linked list further comprising comment insertion objects and comment display objects, the parser writing the linked list of objects to a binary markup file representing the linked list of objects and corresponding to the selected one of the set of source files, each comment display object being capable of being associated with one or more comments" as recited in claim 21 and similarly in claim 39. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50 and column 8, lines 35-40 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 8. Applicant respectfully traverses. There is no language in the cited passages that teaches parsing a source file. Neither is there any language in the cited passages that teaches a linked list of objects.

Neither is there any language in the cited passages that teaches a linked list of objects corresponding to a hypertext representation of a selected source file. Neither is there any language in the cited passages that teaches comment insertion objects and comment display objects. Neither is there any language in the cited passages that teaches a binary markup file representing the linked list of objects and corresponding to the selected one of the set of source files. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 22-24 and 40-41 each recite combinations of features including the above combinations, and thus are patentable for at least the above stated reasons. Claims 22-24 and 40-41 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Gramlich in view of Day and in further view of Tran and in further view of Merritt.

For example, Gramlich, Day, Tran and Merritt, taken singly or in combination, do not teach or suggest "open tag data representing the open hypertext tags, at the location of the comment display object, in the linked list of objects, and in which the common gateway interface program code means for generating a hypertext document further comprises means to insert closing hypertext data in the hypertext document, prior to a selected one of the comments being displayed in the hypertext document, and means to insert reopening hypertext data in the hypertext document, following the selected one of the comments being displayed in the hypertext document, the closing hypertext data and the reopening hypertext data both being defined by the open tag data for the comment display object associated with the selected one of the comments being displayed" as recited in claim 22. The Examiner cites column 12, lines 25-35 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 10. Applicant respectfully traverses. As stated above, Gramlich instead teaches that the annotation proxy inserts HTML tags in the merged document around the pattern to convert the pattern into a hyperlink cue tied to the appended information from the arg field. Gramlich further teaches that when displaying the

merged document, the browser can display an icon at the insertion point, which a user can select to display the inserted text, or can directly display the inserted text at the insertion point. There is no language in the cited passage teaching a linked list of objects. Neither is there any language teaching open, closing or reopening hypertext tags or data. Hence, Gramlich does not teach the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Day, Tran and Merritt, taken singly or in combination, do not teach or suggest "the linked list of objects comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item tag objects, and link tag objects" as recited in claim 23. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50, column 6, lines 15-23 and column 12, lines 32-43 of Gramlich as teaching the above-cited claim limitations. Paper No. 20, page 10. Applicant respectfully traverses. There is no language in the cited passages that teach the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Day, Tran and Merritt, taken singly or in combination, do not teach or suggest "each object in the linked list of objects has a type, and comprises contents derived from a portion of the source file, each comment insertion object and each comment display object comprises a contents line identifier, representing the line number defining the location of the object in relation to the source file, the comment file consists of comment line identifier data associated with the set of comments representing the line numbers in the source file with which each comment is related, and in which the common gateway interface program code means for generating a hypertext document further comprises means to traverse the linked

list of objects, and means to select a display object from the linked list of objects, means to determine the type of the display object, means to generate hypertext data to correspond to the type of the display object and the contents of the display object, means to identify the contents line identifier for the display object and for selecting comment display data from the comment file based on the contents line identifier and the comment line identifiers of the comment file, and means to generate hypertext data from the comment file representing the selected one of the set of comments corresponding to the comment line identifier associated with the contents line identifier" as recited in claim 24. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50, column 6, lines 15-23 and column 12, lines 32-43 of Gramlich as teaching the above-cited claim limitations. Paper No. 20, page 10. In the Office Action, the Examiner is not addressing each of the limitations of the claim. For example, the Examiner has not addressed where a comment insertion object is allegedly taught. In another example, the Examiner has not addressed where a comment display object is allegedly taught. In another example, the Examiner has not addressed where the limitation of "each object in a linked list of objects has a type" is allegedly taught and so forth. The Examiner is reminded that the Examiner may not simply ignore language in the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, the Examiner is reminded that the Examiner cannot reject claims based on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Appellants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 21-24, 39 and 41 as being unpatentable over Gramlich in view of Day and in further view of Tran and in further view of Merritt. M.P.E.P. §2143.

H.   The Examiner has not provided any objective evidence for combining Gramlich with Tran and Merritt.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions.   M.P.E.P. § 2142.   The showings must be clear and particular and supported by objective evidence.   *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999).   Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence.   *Id.*

The Examiner's motivation for modifying Gramlich with Tran and Merritt for providing reviewers with forms for reviewer entry of comments, as recited in claims 25 and 29, "because of Merritt's taught advantage of including comments within a document, providing users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document."   Paper No. 20, page 10.   This motivation is insufficient to support a *prima facie* case of obviousness as discussed below.

As stated above, Gramlich teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents.   Abstract.   Gramlich further teaches that a user of a web browser opens an annotation proxy server between the web browser and the web servers that intercepts all documents retrieved by the web browser and merges with the retrieved documents commentary from sources designated by the user of the web browser that refer to the requested documents. Abstract.   Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory.   Abstract.

As stated above, Tran, on the other hand, teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Abstract.

Merritt, on the other hand, teaches superimposing a second, graphical image on a primary image for annotating the primary image. Abstract. Merritt further teaches that the secondary image is displayed over the primary image as either a mark or glyph. Abstract.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying the primary reference (Gramlich) to provide users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document (Examiner's motivation). *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). The Examiner's motivation appears to have been gleaned from a secondary reference (Merritt). In fact, the Examiner states "because of Merritt's taught advantage of including comments within a document" as support for his motivation. Paper No. 20, page 10. This is not evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him would have been motivated to modify the primary reference (Gramlich) with the teachings of the secondary references (Tran and Merritt). The Examiner's motivation is a motivation for the secondary reference (Merritt) to solve its problem. This is not a suggestion to combine the primary reference (Gramlich) with the secondary references (Day and Merritt). As stated above, the primary reference (Gramlich) teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. The Examiner must provide evidence as to why one of ordinary skill in the art with the primary reference (Gramlich) in front of him, which teaches that an annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the

requested document information only from the annotation directory with the teachings of the secondary reference (Tran), which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen, along with the teachings of the other secondary reference (Merritt), which teaches superimposing a second, graphical image on a primary image for annotating the primary image. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002); *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Merely stating what a secondary reference teaches is <u>not</u> evidence for combining a primary reference (Gramlich) with the secondary references (Tran and Merritt). *See Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 25-32. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Gramlich, which teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents, with Tran, which teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen, along with Merritt, which teaches superimposing a second, graphical image on a primary image for annotating the primary image. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). There is no suggestion in Gramlich of superimposing a second, graphical image on a primary image for annotating the primary image. Neither is there any suggestion in Gramlich that the secondary image is displayed over the primary image as either a mark or glyph. Since the Examiner has not submitted objective evidence for modifying Gramlich with Tran and Merritt, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32. *Id.*

Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to provide reviewers with forms

for reviewer entry of comments. *Id.* There is no suggestion in Gramlich of providing reviewers with forms for reviewer entry of comments. Since the Examiner has not submitted objective evidence for modifying Gramlich to provide reviewers with forms for reviewer entry of comments, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32. *Id.*

As a result of the foregoing, Applicant respectfully asserts that the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32. M.P.E.P. §2143.

I.   Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicant respectfully asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "computer readable program code means for causing a computer to parse a selected one of the set of source files into a linked list of objects corresponding to a hypertext presentation of the selected source file" as recited in claim 25 and similarly in claim 29. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50 and column 8, lines 35-40 of Gramlich as teaching "parsing source documents" and cites column 15, lines 30-39 of Tran as teaching linked list objects. Paper No. 20, page 15. Applicant respectfully traverses. The Examiner has not provided any motivation for modifying Gramlich with Tran to parse a selected one of the set of source files into a linked list of objects corresponding to a hypertext presentation of the selected source file. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 689, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). As the Examiner has not provided any objective evidence for modifying Gramlich with Tran to parse a selected one of the set of source files into a linked list of objects corresponding to a hypertext presentation of the selected source file, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25 and 29. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the linked list further comprising comment insertion objects and comment display objects, the parser writing the linked list of objects to a binary markup file representing the linked list of objects and corresponding to the selected one of the set of source files, each comment display object associated with one or more comments" as recited in claim 25 and similarly in clam 29. As understood by the Applicant, the Examiner cites column 15, lines 30-39 of Tran as teaching the above-cited claim limitation. Paper No. 10, page 8. Applicant respectfully traverses and asserts that Tran instead teaches that the user may enter text and to associated the text with a selected object, e.g., image displayed on a display. The cited passage includes at least no language regarding comment insertion objects, comment display objects, a parser and a binary markup file representing the linked list of objects and corresponding to the selected one of the set of source files. The Examiner is reminded that the Examiner may not simply ignore language in the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, the Examiner is reminded that the Examiner cannot reject claims based on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the hypertext document selectively including hypertext links representing comment insertion objects, the hypertext links providing reviewers with forms for reviewer entry of comments" as recited in claim 25. The Examiner cites column 12, lines 25-35 of Gramlich for teaching common insertion objects and cites column 5, lines 1-6, 64-67 and column 6, lines 1-17 of Merritt as teaching providing reviewers with forms for reviewer entry of comments. Paper No. 20, pages 6 and 10. Applicant respectfully traverses and asserts that Merritt instead teaches that a primary image, e.g., a memo to staff (Figure 2), is transmitted to other users in a routing list. The first user transmits the primary image to a first subsequent

user, indicated in the routing list, so that they can review the primary image and input their annotations using the glyphs or marks by adding new annotations identified by a glyph or mark. After review by the subsequent user, the annotated primary image is transmitted to the next subsequent user for their review and annotation input and so forth. This language is not the same as providing reviewers with forms for their review. Instead, the users in Merritt are provided with the document itself where they can make annotations to that document. But Merritt does not provide the users with a form for reviewer entry for comments. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 26-28 and 30-32 each recite combinations of features including the above combinations, and thus are patentable for at least the above stated reasons. Claims 26-28 and 30-32 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Gramlich in view of Tran in further view of Merritt.

For example, Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the linked list of objects comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item objects and link tag objects" as recited in claim 27 and similarly in claim 31. The Examiner cites column 15, lines 30-39 of Tran and column 9, lines 2-25 and column 13, lines 1-9 of Gramlich as together teaching the above-cited claim limitations. Paper No. 20, pages 6-7. Applicant respectfully traverses. There is no language in the cited passages that teach the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "each object in the linked list of objects has a type, and comprises contents derived from a portion of the source file, each comment insertion object and each comment display object comprises a contents line identifier, representing the line number defining the location of the object in relation to the source file, the comment file consists of comment line identifier data associated with the set of comments representing the line numbers in the source file with which each comment is related, and in which the computer readable program code means for causing the computer to generate a hypertext document further comprises means to traverse the linked list of objects, and means to select a display object from the linked list of objects, means to determine the type of the display object, means to generate hypertext data to correspond to the type of the display object and the contents of the display object, means to identify the contents line identifier for the display object and for selecting comment display data from the comment file based on the contents line identifier and the comment line identifiers of the comment file, and means to generate hypertext data from the comment file representing the selected one of the set of comments corresponding to the comment line identifier associated with the contents line identifier" as recited in claim 28 and similarly in claim 32. The Examiner cites the Abstract, column 3, lines 65-67, column 4, lines 43-50 and column 12, lines 32-42 of Gramlich as teaching the above-cited claim limitation. Paper No. 20, page 7. Applicant respectfully traverses. In the Office Action, the Examiner is not addressing each of the limitations of the claim. For example, the Examiner has not addressed where a comment insertion object is allegedly taught. In another example, the Examiner has not addressed where a comment display object is allegedly taught. In another example, the Examiner has not addressed where the limitation of "each object in a linked list of objects has a type" is allegedly taught and so forth. The Examiner is reminded that the Examiner may not simply ignore language in the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, the Examiner is reminded that the Examiner cannot reject claims based on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed.

Cir. 2002). Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicant respectfully asserts that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32 as being unpatentable over Gramlich in view of Tran and in further view of Merritt.

II. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that claims 1-8, 10, 11 and 13-41 in the Application are in condition for allowance, and Applicant respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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